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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/800,742	02/14/97	FIELD	1233-272A

PMC2/0315
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EXAMINER	
BOUCHER, D	
ART UNIT	PAPER NUMBER
3627	

DATE MAILED: 03/15/99

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UNITED STATES DEPARTMENT OF COMMERCE
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 15

Application Number: 08/800742
Filing Date: February 14, 1997
Appellant(s): Peter Field and Duncan Kerr

Vincent M. DeLuca
For Appellant

MAILED
MAR 15 1999
GROUP 3600

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed March 1, 1999.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

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(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 13, 17-19, 22 and 26 stand or fall together.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,552,777

Gokcebay et al.

9-1996

5,351,042

Aston

9-1994

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(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 13, 17-19, 22, and 26 are rejected under 35 U.S.C. 103(a) as being as being unpatentable over Aston 5,351,042 and Gokcebay et al. 5,552,777. See particularly Aston, figure 4 and column 3, line 50 to column 4, line 3. It would have been an obvious relocation and reversal of parts to mount the nitinol wire and lever 42 in the plug which is accepted into a recess of the casing in a manner similar to that set forth in Gokcebay et al. for the reasons set forth therein.

(11) *Response to Argument*

The Examiner can not agree with appellants' argument that there is no motivation to combine the teachings found in Aston and Gokcebay et al. to make obvious appellants' invention of claims 13, 17-19, 22 and 26. Aston teaches all the elements of these claims with the exception of the nitinol actuator being mounted in the plug. Aston further teaches that the nitinol actuator can replace (i.e. functionally equivalent to) a solenoid actuator. See column 3, lines 50-52. Gokcebay et al. teaches the benefits of housing the electronic access feature of a cylinder lock in

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the mechanical lock plug itself. Gokcebay et al. further teaches that it is well within the skill level of the person of ordinary skill to mount a solenoid actuator within the plug of the cylinder. The Examiner maintains that the person of ordinary skill in the art would be motivated by the teachings of Aston and Gokcebay et al. to arrive at appellants' claimed invention for the reasons set forth in these references.

In response to appellants' arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Appellants' have no legal basis for requiring that Gokcebay suggest "within its four corners" making the modification proposed by the Examiner. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The Examiner maintains that the person of ordinary skill would know how to make the mechanism of Aston small enough that it could be incorporated into the plug of the key lock in the same manner as that set forth by Gokcebay et al. Gokcebay et al. teaches that a solenoid can be made small enough to fit within the plug to provide the benefit of a self-contained electronic plug which is less bulky than a cylinder lock where the electronics are contained in the cylinder housing. See


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Gokcebay et al. at column 3, lines 2-5 which states in pertinent part "in preferred embodiments, all electronics and hardware are contained in the cylinder plug, aside from a small recess or bore which is provided in the cylinder shell". Aston teaches a nitinol wire actuator which is an art-related equivalent to an electromagnet or solenoid and the bulkier electronic lock having the electronic actuator located in the cylinder housing. A person of general skill in the art at the time the invention was made armed with the complete teachings of Aston and Gokcebay would have been motivated to make the combination proposed by the Examiner absent any suggestion by appellants. The references make obvious appellants claims and the Examiner maintains that she has stated a *prima facie* case of obviousness without any improper hindsight reasoning.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

dmb
March 13, 1999


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